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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/603,665	BARRY ET AL.
	Examiner Suryaprabha Chunduru	Art Unit 1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 June 2000.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17 2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15 and 20-24, drawn to an isolated nucleic acid, expression vector and host cells, all requiring SEQ ID Nos. 1-13, classified in class 536, subclasses 23.1 and class 435 and subclasses 6 and 320.1.
- II. Claims 16-19, drawn to polynucleotides, all requiring SEQ ID Nos. 1-13, classified in class 536, subclass 22.1.
- III. Claims 25-44, drawn to method of genotyping, classified in class 435, subclass 6.
- IV. Claims 46-47, drawn to purified polypeptide and antibody, requiring SEQ ID NO. 5, classified in class 435, subclass 69.1.
- V. Claims 48-49, drawn to method of screening substances that interact with BAP28 polypeptide, requiring SEQ ID Nos. 1 and 5, classified in class 435, subclass 6.
- VI. Claims 50-56, drawn to computer readable medium having stored sequences, requiring SEQ ID Nos. 1-13, classified in undeterminable class and undeterminable subclass.
- VII. Claims 57-64, drawn to use of polynucleotides, classified in class 536, subclass 22.1.

The inventions are distinct, each from the other because of the following reasons:

Group I is independent from each of Groups II - VII because the isolated nucleic acids, expression vector, host cells are materially different from (a) polynucleotides of Group II; (b) method of genotyping of Group III; (c) purified polypeptides of Group IV; (d) method of screening substances of Group V; (e) computer readable medium of Group VI and (f) use of

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polynucleotides of Group VII. The polynucleotides and polypeptides of Groups II and IV may be obtained from naturally occurring sources or may be synthesized chemically. Neither is any of the polynucleotides or polypeptides claimed in Groups II or IV needed to produce or practice the invention of Group I. The method of genotyping of Group III and the method of screening substances that interact with BAP28 polypeptide of Group V may be processed in materially different assays such as paternity testing and mutagenesis assays. Neither is any of the methods claimed in Groups III or V needed to practice the invention in Group I.

Group I is independent and distinct from each of groups II -VII because (a) poly-nucleotides of Group II can be used in hybridization assays and can be obtained from naturally occurring sources or can be synthesized chemically; (b) method of genotyping of Group III can be used in gene-knockout assays; (c) purified polypeptides and antibody of Group IV can be used in in-situ detection and ligand binding assays; (d) method of screening substances of Group V can be used in mutagenesis assays; (e) use of polynucleotides of Group VII can be used in gene therapy.

Inventions in Group I, II and IV are independent and distinct, each from the other, because they are the products which differ in functionality and has independent utility, that is distinct for each invention. The isolated nucleic acids, expression vectors and host cells of Group I can be used in transfection assays, the polynucleotides of Group II can be used in polymerase chain reaction assays and the polypeptides of Group IV can be used in ligand binding or making fusion protein.

Inventions II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group II can be used in materially different process such as gene therapy.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

In this application additionally, no matter which group applicant elects, applicant is required to specify one specific nucleotide sequence for examination. This requirement is made under 1192 O.G. 68 Notice (November 19, 1996), as the examination of more than one sequence in the application would result in an undue search burden on the PTO.

Claim 45 is drawn to a kit and link(s) inventions of Group I-Group II. They will be examined with the election of Groups I-II.

Election of Species:

This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Claims 4, 5, 43, 44, 50, 56 and 62-64 are drawn to a purified or isolated nucleic acid comprising a BAP28-related biallelic marker selected from the group consisting of A1 to A58 and the complementary sequences thereof;

- b. Claim 13 is drawn to a recombinant polynucleotide consisting essentially of a sequence selected from the sequences B1 to B38 and C1 to C38;
- c. Claim 12 is drawn to a polynucleotide consisting essentially of a sequence selected from the sequences D1 to D58 and E1 to E58;
- d. Claim 8 is drawn to a polynucleotide consisting essentially of a sequence selected from the sequences P1 to P58 and the complementary sequences thereto.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

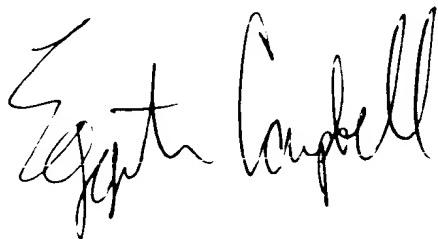
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M. Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

SK
Suryaprabha Chunduru
March 13, 2001



**EGGERTON A. CAMPBELL
PRIMARY EXAMINER**